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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,680	06/29/2001	Brad A. Armstrong	29	8703

7590 06/22/2006

Brad A. Armstrong
P.O. Box 2048
Carson City, NV 89702

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

82

Office Action Summary	Application No. 09/896,680	Applicant(s) ARMSTRONG, BRAD A.	
	Examiner Corbett B. Coburn	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 and 54-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. On 1 June 2006, Applicant filed a Request for Continued Examination (RCE). Applicant did not file any amendments to the claims. Therefore, the rejection contained in the previous office action dated 1 December 2005 is incorporated herein by reference and is maintained.

Response to Arguments

2. Applicant's arguments filed 1 June 2006 have been fully considered but they are not persuasive.

3. Applicant states that Applicant and two other Examiners believe that Furakawa does not teach the present invention. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's "Formal Request" that Examiner have someone competent to assist him in his examination of this case is noted – and denied. Examiner is a Primary Examiner in this art and is competent under the law to examine the instant Application. If Applicant wishes to petition for supervisory review of this action, please see 37 CFR 1.181.

5. Applicant's arguments regarding "discrete pressure buttons" were addressed in the previous office action – which see.

6. Applicant points out that Furakawa does discuss non-analog switched. However, Applicant fails to note that these switched are discussed in connection with the prior art – not Furakawa's invention. Furthermore, as pointed out in the previous office action, Furakawa specifically states that these non-analog switches are unsuited for use in video game controllers.

Art Unit: 3714

In paragraph 0004, Furakawa specifically says, "Thus, the rubber contact 1 merely effects an electrical on/off operation, and **does not enable the operator to freely control**, for example, **the operation of a character in a video game.**" (Emphasis added.)

7. Furakawa's invention is a video game controller. If Furakawa says that non-analog switches are unsuited to use in such controllers and discloses analog switches that are suited to these controllers, it is reasonable to infer that the disclosed controller makes use of these analog switches. It is unreasonable to adopt the position that Furakawa teaches use of analog switches on one side of the controller while teaching the use of unsuitable digital switches on the other side of the controller. Furakawa specifically states that the object of his invention is to solve the problem posed by use of these digital switches in a video game controller. (Paragraph 0005)

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

Art Unit: 3714

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Furakawa teaches the claimed analog switch but does not go into the details of switch construction. Thus one of ordinary skill in the art would have been motivated to seek a prior art switch that was capable of performing the function described in Furakawa. Terajima teaches such a switch. Where a reference teaches a structure to perform a function but fails to give details as to the implementation of this structure, there is ample motivation to seek a prior art reference to teach these details.

10. Applicant argues that some of Furakawa's buttons are not discrete. Examiner points out that some are – and that having two discrete buttons meets the claimed limitations.

11. Applicant's use of the phrases "trigger keys" and "steering keys" are merely recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

12. Applicant argues that Sony's licensing of Applicant's products should be considered as evidence of secondary considerations. Applicant must surely know that "secondary considerations" do not apply to claims that are anticipated (i.e., rejected under 35 USC §102) by the prior art. Furthermore, to the extent that some claims are rejected under 35 USC §103, there was no nexus between the claimed invention and Sony's license.

13. Applicant is reminded that he may appeal this rejection by following the procedures outlined in Chapter 1200 of the M.P.E.P.

Conclusion

14. This is an RCE of applicant's earlier Application No. 09/896,680. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

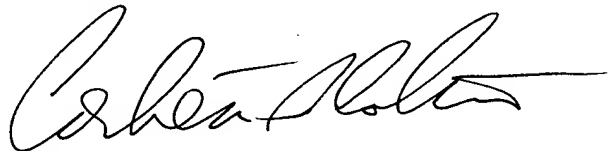
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Corbett B. Coburn
Primary Examiner
Art Unit 3714

**CORBETT B. COBURN
PRIMARY EXAMINER**